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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,447	01/02/2002	Bernhard Bosshard	003780-048	8140

7590 10/28/2003

B. Jefferson Boggs, Jr.  
BURNS, DOANE, SWECKER & MATHIS, L.L.P.  
P.O. Box 1404  
Alexandria, VA 22313-1404

EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 10/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/032,447

Applicant(s)

BOSSHARD ET AL.

Examiner

David Buttner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 12-31 is/are pending in the application.
- 4a) Of the above claim(s) 16, 18 and 31 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30 is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-15, 17, 19-25, 27-29 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

New claim 31 is properly grouped with non-elected claims 16 and 18. It is considered non-elected.

Claims 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are either non-limiting or lack antecedent basis. The only polycarbonate polyol phrase present in claim 1 is the "non polycarbonate polyol." Further limiting the definition of polycarbonate polyol cannot limit the scope of the claim as no polycarbonate polyol is permitted as pre-polymer (2).

If referring to pre-polymer (1), there is no antecedent basis for polyol.

Claims 1-6, 8-10, 12-15, 17, 19-21, 23-25 and 27-29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Gruber '386 Patent.

Gruber exemplifies (Nos. 1, 3, 5) adhesives containing a polycarbonate dimethacrylate, a polyethylene glycol dimethacrylate, peroxide etc. The polycarbonate dimethacrylate qualifies as a polycarbonate prepolymer. The polyethylene glycol dimethacrylate qualifies as a prepolymer based on a polyether polyols.

Fillers (column 6, line 1) can be included.

Claims 1-10, 12-15, 17, 19-25 and 27-29 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the JP 02003489 Patent.

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The reference blends a prepolymer (A) having isocyanate groups with a polyfunctional compound (B) and fillers to form an adhesive. According to the chemical abstract, the polyfunctional compound (B) can be polyoxypropylated glycerol, which is a polyether polyol. According to the Derwent abstract (A) can be a polycarbonate.

Claim 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Gruber and J'489 are not believed to suggest carbon black filler. Neither reference suggests claim 30's polyisocyanate-polyether polyol (c).

Applicant's arguments filed 8/07/03 have been fully considered but they are not persuasive.

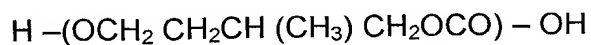
Applicant argues Gruber utilizes a peroxide to cure his unsaturated composition rather than by moisture, diamines etc.

This is not convincing. Applicant's claims do not require any particular curing agent to be present. In fact, claim 1 does not require any specific groups on the pre-polymers to render the composition moisture curable.

Applicant's argument's regarding J0 2003489 are not understood.

The Derwent abstract clearly states (A) can be a polyester or polycarbonate, (A) contains terminal isocyanate groups. The most logical way to arrive at such a structure is to react diisocyanate with polyesterdiol or polycarbonate diol. This is the procedure exemplified in the chemical abstract; MD1 (a diisocyanate) is reacted with poly valerolactone glycol (a polyester diol).

Analogously, the polycarbonate version would be formed by reacting diisocyanate with a polycarbonate diol of the formula:



Arguments regarding carbon black, windscreen antennas, cure mechanisms etc. are not relevant because the rejected claims do not require the presence of the elements.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is (703) 308-2403. The examiner can normally be reached on weekdays from 10 a.m. to 5 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

DAVID J. BUTTNER  
PRIMARY EXAMINER

D. Buttner/dh  
October 21, 2003

*David Buttner*